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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/634,369	08/09/00	LIAO	18587-1023

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BOSTON MA 02111

LI, G	EXAMINER
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ART UNIT 1632	PAPER NUMBER
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DATE MAILED: 10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/634,369

Applicant(s)

LIAO ET AL.

Examiner

Janice Li

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S. C. 121:

- I. Claims 1-9 are drawn to a composition comprising a matter selected from the group consisting of epoxyeicosatrienoic acids (EETs), their metabolic products, and analogs. Classified in class 514, subclass 475.
- II. Claims 10-19, 21, 25-28 are drawn to a method for treating inflammation or preventing cell death comprising administering to a subject a therapeutically effective amount of a composition of a matter selected from the group consisting of epoxyeicosatrienoic acids (EETs), their metabolic products, and analogs. Classified in class 514, subclass 475.
- III. Claims 20, 22, 23, 24, 29, and 30 are drawn to a method for treating inflammation using a recombinant polynucleotide expressed cytochrome P450 epoxygenase. Classified in class 514, subclass 44.
- IV. Claims 22 and 29 are drawn to a method for treating inflammation or preventing cell death using a cytochrome P450 epoxygenase protein. Classified in class 514, subclass 2.
- V. Claims 31 and 32 are drawn to a method of screening for a compound. Classified in class 435, subclass 4.

2. The inventions are distinct, each from the other because of the following reasons.

Inventions II-V and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, Groups II-V are different methods for drug screening and for treating or preventing inflammation using compounds, polynucleotides and proteins. The different methods have different method steps, different modes of operation, use different starting materials, different test criteria, and have distinct technical considerations. The differences of the Inventions I-V are further underscored by their divergent classification and independent search criteria.

Invention Groups II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the compounds could be used in a material different process other than treating inflammatory diseases, and the inflammatory diseases could be treated with a materially different product such as glucocorticosteroids.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different search criteria, it would impose a search burden to the Office if all claims are to be examined together, thus, restriction for examination purposes as indicated is proper.

3. This application contains claims directed to the following patentably distinct species of the claimed invention: compositions comprises matter selected from the group consisting of epoxyeicosatrienoic acids (EETs), their metabolic products, and analogs are directed to patentably distinct species. If one of the inventions I-IV is elected, further election of a species is necessary.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, i.e. a species from matters selected from the group of epoxyeicosatrienoic acids (EETs), their metabolic products, and analogs, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-30 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is advised that where a single claim encompasses more than one invention as defined above, upon election of an invention for examination, said claim would only be examined to the extent that it reads upon the elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Q. Janice Li whose telephone number is 703-308-7942. The examiner can normally be reached on 8:30 am - 5 p.m., Monday through Friday.

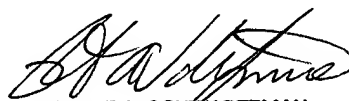
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen M Hauda can be reached on 703-305-6608. The fax numbers for the organization where this application or proceeding is assigned are 703-308-8724 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of formal matters can be directed to the patent analyst, Kay Pinsky, whose telephone number is (703) 305-3553.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235. The faxing of such papers must conform to the notice published in the Official Gazette 1096 OG 30 (November 15, 1989).

Q. Janice Li
Examiner
Art Unit 1632

QJL
October 22, 2001


ROBERT A. SCHWARTZMAN
PRIMARY EXAMINER